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Remarks

As a preliminary matter, the indication of allowable subject matter in claims 6, 7, 12, and 14 to 18 is acknowledged with gratitude.

Also as a preliminary matter, claims 9 and 11, directed to a one-piece golf ball or to a center, core, or mantle of a golf ball including a composition of the invention, and claims 21 to 25, directed to a process for making a composition of the invention, are cancelled without prejudice herein. Applicants intend to resume prosecution of these claims in a continuing application.

Rejection under 35 U.S.C. § 112, 2nd paragraph

Claim 20 is amended herein to accord the recited minimum amount of monomeric organic acid, or salt thereof, to the amount recited in claim 8, from which claim 20 ultimately depends. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 112, 2nd paragraph, be withdrawn upon reconsideration.

Rejection under 35 U.S.C. § 103

Claims 1, 4, 5, 8 to 11, 13, and 19 to 25 stand rejected under 35 U.S.C. § 103 as obvious over published UK Patent Appln. No. GB 2 164 342 (hereinafter "GB '342") in view of U.S. Patent No. 6,100,321, issued to John Chu Chen (hereinafter "Chen '321"), or International Publication No. WO98/46671, of which John Chu Chen is the sole inventor (hereinafter collectively the "Chen References"). Claims 9, 11, and 21 to 25 are cancelled without prejudice herein. Therefore, the rejection under 35 U.S.C. § 103 is the sole reason presented in the Official Action dated February 3, 2004, why claims 1, 4, 5, 8, 10, 13, 19, and 20 should not be allowed. Applicants respectfully traverse this rejection for the reasons set forth below.

First, the Official Action has not set forth a *prima facie* case for the obviousness of claims 1, 4, 5, 8, 10, 13, 19, and 20. It is well established that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference

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or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

M.P.E.P. § 2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *Emphasis supplied*.

Applicants respectfully submit that the GB '342 reference in combination with the Chen References does not set forth every element of the claimed invention. In independent claims 1 and 8, the acid copolymer is allowed to be a bipolymer (the amount of Y may be 0 wt.%), while at least 95% neutralization of the acid in both the acid copolymer (a) and the high molecular weight, monomeric organic acid (b) is required. GB '342, however, does not teach or suggest inclusion of monomeric organic acids or salts. It follows by logic that this reference cannot possibly teach or suggest neutralization of about 95-110% of the total acid equivalents resulting from both the ethylene/acrylic acid and monomeric organic acid, as is specifically recited in claims 1 and 8.

Moreover, the Chen References are cited as a basis to include monomeric organic acids in the compositions of GB '342. In passing, Applicants respectfully note that the Official Action has not demonstrated, as the above-quoted portion of the M.P.E.P. plainly requires, that the motivation for modifying or combining GB '342 with the Chen references is contained within these references. Nevertheless, the Chen References do not teach or suggest that monomeric organic acid salts can be added to highly neutralized (greater than 90%) ionomers. Rather, Chen '321 teaches that level of neutralization of ionomers can be 10 – 90%. When using stearic acid, Chen '321 teaches still lower neutralization, stating "it is possible to prepare the materials of the invention by adding stearic acid, rather than a stearate, since in effect, polymer with metal stearates, with somewhat lower level of neutralization of the ionomer will result." (see col. 4, ll. 17 – 19 and col. 6, ll. 41 – 46).

It is also well established that each reference cited in a rejection under 35 U.S.C. § 103 must be taken as a whole. Applicants respectfully

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maintain that one skilled in the art, without the benefit of impermissible hindsight, and taking each of the cited references as a whole, would be led to a neutralization range with a lower limit of 60% (to comply with the teachings of GB '342) and an upper limit of 90% (to comply with the teachings of the Chen References). The combination of references cited therefore simply does not teach or suggest a neutralization level of about 95-110%, as is clearly recited in Applicants' claims 1 and 8.

Because claims 1 and 8 are not obvious, it follows by statute that claims 4, 5, 10, 13, 19, and 20, which depend, directly or indirectly, from claim 1 or claim 8, are also not obvious.

Second, claim 8 is believed to be allowable for at least the same reasons why claim 17 is also allowable. Claim 8, like claim 17, is drawn to golf balls or golf ball components including a composition of the invention. Claim 8, like claim 17, includes about 0-50 wt% of an acid copolymer; about 10-45 wt% of a high molecular weight, monomeric organic acid or salt thereof; about 1-35 wt% of a thermoplastic elastomer; and a cation source. Filler, which is required in claim 17, is optional in claim 8. Claim 8, however, like claim 17, also does not require that the acid copolymer be a terpolymer. Finally, Claim 17 includes an even broader range of neutralization levels than claim 8. Applicants therefore respectfully request that claim 8 be allowed for at least these reasons.

Finally, Applicants respectfully submit that the rejection under 35 U.S.C. § 103 is procedurally improper for failure to meet the requirements of the Patent Rules. In the Amendment dated November 26, 2003, Applicants set forth portions of the above and other facts and reasoning in response to the outstanding rejection for obviousness that is now repeated in the Official Action of February 3, 2004. The Official Action has rejected the facts and reasoning in the Amendment, however, stating that "[t]he 90% maximum [neutralization taught in the Chen References] was in all likelihood due to the low melt index associated with high neutralizations" and "[o]ne would expect metal stearates to function in the composition of GB '342." (Official Action at page 3; *emphasis supplied*.)

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Applicants respectfully take issue with this form of rejection. It is well established that

(i) in rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. ... In rejecting claims the examiner ... may also rely upon facts within his or her knowledge...

37 C.F.R. § 1.104(c)(2) and (3); *emphasis supplied*. Applicants respectfully submit that the reasons set forth in the Official Action for repeating the rejection for obviousness represent impermissible speculation rather than facts ("in all likelihood", "[o]ne would expect"). Applicants therefore respectfully request that this rejection be withdrawn upon reconsideration, as not in compliance with the plain requirements of 37 C.F.R. § 1.104(c). In the alternative, Applicants respectfully request that additional references be cited to support facts forming the basis on which the rejection is repeated, or that the Examiner set forth any facts within his personal knowledge that are relied upon in the present prosecution in an affidavit that meets the requirements of 37 C.F.R. § 1.104(d)(2).

In conclusion, Applicants respectfully submit that the Official Action of February 3, 2004 has not made out a proper *prima facie* case for the obviousness of the present claims. In the alternative, Applicants respectfully submit that the facts and reasoning presented herein are sufficient to overcome a *prima facie* case of obviousness based on the combination of GB '342 and the Chen References. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn upon reconsideration, and that the present application be passed rapidly to issue.

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Conclusion

In view of the above remarks and amendments, it is felt that all claims are in condition for allowance, and such action is respectfully requested. Should any fee be required in connection with the present amendment, the Examiner is authorized to charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company). Should the Examiner believe that an interview or other action in Applicants' behalf would expedite prosecution of the application, the Examiner is urged to contact Applicants' attorney by telephone at (302) 992-3219.

Respectfully submitted,



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